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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,871	10/06/2000	David Allison Bennett	PSTM0003/MRK/STM	2829

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/684,871

Applicant(s)

BENNETT ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6, 7, 9, 10</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The declarations filed with the Information Disclosure Statement #7, filed 8/22/01, are not considered to be proper IDS references. They have been reviewed and considered and placed in the file, however are not considered to be a "reference cited".

### ***Specification***

2. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-3, 8-10, and 15-17 recite the limitation "each user client computer device".

There is insufficient antecedent basis for this limitation in the claims. The claims have

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previously recited a client computer device, but have not claimed a user client computer device, therefore it is unclear if they are one in the same.

6. With respect to Claims 1, 8 and 15: the phrase “rules for each of a plurality of carriers” is indefinite. It is unclear as to each what, of a plurality of carriers. Is this “each carrier of a plurality of carriers”? It is unclear to the examiner what the word “each” is referring to, therefore it is unclear what or who the rules apply to or for.

7. With respect to Claims 4, 11, and 18: the phrase “collect as parcel specifications for a particular parcel user input”. This portion of the claim is a run on sentence, therefore causing the claim to be unclear and ambiguous. So it is unclear what is being collected. The examiner suggests the use of commas, in the claims to clarify what is exactly being claimed.

8. With respect to Claim 4, 11 and 18: This Claim is rejected for being grammatically incorrect. A sentence must end in a period; claim 4 ends in a semicolon, therefore it is unclear if there is more to the claim or not.

9. Claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20 and 21 recite the limitations "the particular requesting user" and “the particular user”. There is insufficient antecedent basis for this limitation in the claims. Previously in the independent claims, it was recited “any particular user”, therefore it is unclear which user is “the particular requesting user” or “the particular user”.

### ***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. The basis of this rejection is set forth in a two-prong test of:

- a. whether the invention is within the technological arts; and
- b. whether the invention produces a useful, concrete, and tangible result.

13. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e. the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts. In the present case, Claims 1-14 only recites an abstract idea. The recited steps of merely applying rules to a set of information, identifying carriers that supports those rules, and calculating rates does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. Even though the claim recites the user accessing a computer system, these steps only constitute an idea of how to apply these rules to choose one carrier over another, they do not require the use of the computer system to do them.

14. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise

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abstract idea unless there is a positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps require anything in the technological arts, as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore the preamble is taken to merely recite a field of use.

15. Additionally for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces calculated rates for carriers used in selecting a specific service for shipping (i.e., useful and tangible).

16. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, Claims 1-14 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholls et al. (5,485,369).

19. With respect to Claims 1-21: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the

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computer system, which instructs the computer to (column 4, lines 8-24, and columns 15-27) collect parcel specifications, such as weight and dimensions as well as origin and destination addresses (Figures 4A and 4B) and a default location (columns 17 and 18, Table II), and to use shipping rules to calculate rates for the shipment (column 4, lines 49-55, column 5, lines 34-40, columns 25 and 26, line 39). Nicholls discloses using the origin and destination zip codes and zones (column 8, lines 43-55). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according to the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses storing this information into a database (Column 7, lines 53-67). Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

### *Conclusion*

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vaghi (6,047,273) discloses the use of a method of shipping where multiple shipping rates are given for multiple carriers, Thiel (6,035,291) discloses the use of an automatic selection of carrier from a plurality of carriers Boucher (6,078,889) discloses the use of a carrier library, Piccione (4,495,581) discloses the use of a postal rate calculator with multiple carrier selection, Danford-Klien et al. (6,047,271) discloses a computer rating system for multiple carriers, Hisbani et al (EP 0943904) discloses calculated rates being based on the class of service

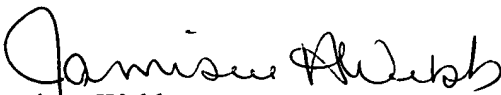
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provided for shipping, and ABF freight systems ([www.abfs.com](http://www.abfs.com)) discloses a press release of a program that calculates shipping rates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jamisue Webb

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